UNITED STATES PATENT AND TRADEMARK OFFICE

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09/678,252	10/03/2000	Karl L. Ginter	7451-0001-15	5246

22852	7590	06/01/2004	**EXAMINER**

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _01 March 2004_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _91-112_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) _104 and 105_ is/are allowed.

6) ☒ Claim(s) _91-103 and 106-112_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _03 October 2000_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _13_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-112 have been presented for examination. Claims 2-90 have been canceled and

new claims 91-112 have been added in a preliminary amendment filed 10/03/2000. Claim 1 has

been cancelled and claims 97-99 and 112 have been amended in an amendment filed 03/01/2004.

Claims 91-112 have been examined.

Priority

2.   Acknowledgment is made that the instant application is a continuation of Application No.

09/328,671, filed 06/09/1999, now U.S. Patent No. 6,389,402 B1, which is a continuation of

Application No. 08/964,333, filed 11/04/1997, now U.S. Patent No. 5,982,891 A, which is a

continuation of Application No. 08/388,107, filed 02/13/1995, now abandoned.

Drawings

3.   The drawings filed on 10/03/2000 are acceptable as indicated on the "Notice of

Draftperson's Patent Drawing Review," PTO-948, attached to this Office action.

Response to Amendment

4.   The amendment to claim 99 filed on 03/01/2004 does not comply with the requirements

of 37 CFR 1.121(c)(2) because it indicates a status of "Previously Presented," rather than

"Currently Amended." Amendments to the claims filed on or after July 30, 2003 must comply

with 37 CFR 1.121(c)(2) which states:

When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

Response to Arguments

5.   Applicant's arguments filed 03/01/2004 with respect to claims 91-103 and 106-112 have been fully considered but they are not persuasive. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. See MPEP § 2111 and *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The applicant argues that the prior art as applied does not recite a rule as described in the instant application (see remarks of amendment C, filed 03/01/2004, Paper No. 14, page 11, lines 14-15; page 13, lines 3-4 and 15-17; page 14, lines 1-4). The applicant may be his own lexicographer; however, any special meaning assigned to a term must be sufficiently clear in the specification. See MPEP § 2111 and *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). In the instant application, the applicant has described rules as implemented in securely moving, accessing, modifying, or using electronic information regarding how, when, where, and by whom such activities can be performed (see specification, page 13, lines 13-25). Particularly concerning the subject matter of claims 91-103, reciting receiving subsequent rules, the applicant has pointed out that another party can modify rules of content control information to apply to all, to classes of, and/or to specific content, and

/or to classes and/or specific users and/or user nodes (see specification, page 44, lines 24-30;

page 45, lines 1-4; page 111, lines 17-30; and page 112, lines 1-26). Specifically concerning the

subject matter of claims 108-112, reciting receiving a subsequent control, where usage related

control information consists of rules and mediating data (see specification, page 34, lines 7-29),

newly proposed content control information interacts with control information already in place to

modify activities applied to all, to classes of, and/or to specific content, and/or to classes and/or

specific users and/or user nodes (see specification, page 44, lines 24-30; page 45, lines 1-4; page

111, lines 17-30; and page 112, lines 1-26).

6.   As per claims 91-93 rejected under 35 U.S.C. 102(b) as being anticipated by Callais et

al., U.S. Patent No. 3,790,700 A, Callais et al. disclose that the subscriber inserting a key in a

key control unit which enables a subscription TV request (see column 5, lines 14-18; figure 1,

item 41). This feature is within the scope of a rule to control the use of specific content for a

specific user. Callais et al. particularly describe that the key enables the subscriber to view the

previewed program and be billed for it.

7.   As per claims 91-94 rejected under 35 U.S.C. 102(b) and (f) as being anticipated by

Shear, U.S. Patent No. 5,050,213 A, the request of the user causes the computer to strip off

contents of the encrypted fields to be sent to the decoder/biller block (see column 11, lines 28-

42; figure 1, blocks 100, 200, and 300; figure 2, block 108c). This element is consistent with a

rule to control decryption of blocks of information to be viewed by the user. Shear shows that

that the user request is a rule allowing the user-selected content to be decrypted with the

decryption key/CRC field for viewing and be billed for it.

8.   As per claims 95-103 rejected under 35 U.S.C. 102(b) and (f) as being anticipated by

Shear, U.S. Patent No. 5,050,213 A, Shear points out that the user request causes the computer to

access separate database blocks for decryption with the decryption key/CRC field and billing by

the decoder/biller block (see column 11, lines 28-42; figure 1, blocks 100, 200, 300; figure 2,

blocks 106 and 108c). The user request represents a rule set made up of rules specifying the

decryption, viewing, and billing for particular blocks of data that the user has selected.

9.   As per claims 108 and 109 rejected under 35 U.S.C. 102(b) and (f) as being anticipated

by Shear, U.S. Patent No. 5,050,213 A, Shear illustrates the received user request to control the

computer to strip off contents of the encrypted fields to be sent to the decoder/biller block (see

column 11, lines 28-42; figure 1, blocks 100, 200, and 300; figure 2, block 108c). The user

request is within the scope of a control to allow a particular user to access particular data at a

particular node.

10.   As per claims 110-112 are rejected under 35 U.S.C. 102(b) and (f) as being anticipated by

Shear, U.S. Patent No. 5,050,213 A, Shear depicts sending a user request to cause the decryption

key fields to be sent to the decoder/biller for storage for processing user-selected information

blocks (see column 11, lines 28-42; figure 1, blocks 200 and 300; figure 2, block 108c). This

feature represents a second received digital control for a particular user to access certain

information blocks at a particular system.

11.   As per claims 106 and 107 rejected under 35 U.S.C. 102(e) as being anticipated by Stefik

et al., U.S. Patent No. 5,638,443 A, Stefik et al. describe that the play request is received by

stating "the requester sends the server a message to initiate the play transaction," (see column 36,

lines 23-24). Stefik et al. additionally show that master repository provides an identification

certificate to a requesting repository (see column 7, lines 15-20; figure 2, items 201 and 205),

which the requesting repository, in turn, sends it to rendering repository where authorization is

required (see column 7, lines 1-14; figure 2, items 202 and 203). They also point out that the

play request and registration message govern the use of the item (see column 36, lines 36-37)

upon authorization (see column 28, lines 39-43). Stefik et al. further specify audit-related

information regarding the use of the item and the identities of the repositories involved in the

usage transaction (see column 29, lines 55-61). Stefik et al. essentially describe the request and

registration message as subsequent controls that control the use of particular digital content by a

particular user at a particular user node.

12.   Applicant's arguments, see remarks of amendment C, Paper No. 14, filed 03/01/2004,

page 14, lines 17-21 and page 15, lines 1-19, with respect to claims 104 and 105 rejected under

35 U.S.C. 102(e) as being anticipated by Stefik et al., U.S. Patent No. 5,638,443 A, have been

fully considered and are persuasive. The rejection of claims 104 and 105 has been withdrawn.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

(f) he did not himself invent the subject matter sought to be patented.

14.   Claims 91-93 are rejected under 35 U.S.C. 102(b) as being anticipated by Callais et al.,

U.S. Patent No. 3,790,700 A.

As per claim 91, Callais et al. illustrate a method of using a governed item at a processing

arrangement including:

receiving a first rule at the processing arrangement (see column 5, lines 4-10; figure 1,

items 16, 25, and 31; transmitting a preview enable command downstream to the control circuit

to allow a subscription TV program to be previewed on a predetermined channel);

receiving a second rule at the processing arrangement, being received independently from

the first rule and from the governed item (see column 5, lines 14-18; figure 1, item 41; the

subscriber inserting a key in a key control unit which enables subscription TV request); and

at the processing arrangement, employing the first rule and the second rule to securely

govern at least one aspect of access to and use of the governed item (see column 5, lines 36-40;

figure 1, items 45 and 17; combining the pay TV request signal and channel code and

transmitting the combined signal to initiate a downstream signal to enable viewing), and

storing audit-related information relating to the access and use (see column 5, line 41; confirming that the subscriber has been billed).

As per claim 92, Callais et al. further point out:

the first rule is indirectly received from a first entity (see column 5, lines 4-10; figure 1, items 16, 21, 25, and 31; the local processing center (LPC) transmitting a preview enable command downstream through a cable drop line); and

the second rule is indirectly received from a second entity different from the first entity (see column 5, lines 14-18; figure 1, item 41; the subscriber inserting a key in a key control unit which enables subscription TV request).

As per claim 93, Callais et al. additionally mention:

receiving the governed item along with the first rule (see column 5, lines 4-10; figure 1, items 17, 21, and 25; transmitting the preview enable command with the subscription TV program).

15.   Claims 91-103 and 108-112 are rejected under 35 U.S.C. 102(b) and (f) as being anticipated by Shear, U.S. Patent No. 5,050,213 A.

As per claim 91, Shear describes a method of using a governed item at a processing arrangement including:

receiving a first rule at the processing arrangement (see column 11, lines 28-42; figure 1, blocks 100, 200, and 300; figure 2, block 108c; the request of the user causes the computer to strip off contents of the encrypted fields to be sent to the decoder/biller block);

receiving a second rule at the processing arrangement, being received independently from the first rule and from the governed item (see column 19, lines 15-22; figure 3, block 314; permitting the user to store in the decoder/biller ceilings on database usage or cost of usage based on usage, period of time, and/or type of information which can be decrypted); and

at the processing arrangement, employing the first rule and the second rule to securely govern at least one aspect of access to and use of the governed item (see column 11, lines 8-14; column 12, lines 47-52; figure 1, block 300; figure 2, blocks 108b and 108c; decrypting the information with the decryption key; see column 19, lines 22-26; figure 4a, block 410; until the total of decrypted data exceeds the user-specified parameter value), and

storing audit-related information relating to the access or use (see column 19, lines 22-26; figure 1, block 200; figure 4a, block 416; keeping a running total of the parameters that the user has specified).

As per claim 92, Shear further mentions:

the first rule is directly and indirectly received from a first entity (see column 11, lines 36-42; figure 1, blocks 200 and 300; figure 2, block 108c; sending the decryption key field to the decoder/biller; column 11, lines 23-27; where the data communications pathway between the host computer and the decoder/biller may be a shared data bus or a network); and

the second rule is directly or indirectly received from a second entity different from the

first entity (see column 19, lines 15-22; figure 3, block 314; permitting the user to store in the

decoder/biller ceilings on database usage or cost of usage based on usage, period of time, and/or

type of information which can be decrypted).

As per claim 93, Shear then points out:

receiving the governed item along with the first rule (see column 11, lines 36-42; figure

1, blocks 200 and 300; figure 2, blocks 108 b and 108c; sending the blocks of information along

with the decryption key field to the decoder/biller).

As per claim 94, Shear additionally delineates:

at least a portion of the governed item is received in an encrypted state (see column 11,

lines 34-42; figure 2, blocks 106, 108b, and 108c; loading one or more blocks of the stored

database information consisting of encrypted fields and decryption keys); and

employing the first rule and the second rule to securely govern at least one aspect of

access to and use of the governed item includes decrypting at least a portion of the governed item

(see column 11, lines 8-14; column 12, lines 47-52; figure 1, block 300; figure 2, blocks 108b

and 108c; decrypting the information with the decryption key; see column 19, lines 22-26; figure

4a, block 410; until the total of decrypted data exceeds the user-specified parameter value).

As per claim 95, Shear depicts a method for using a governed item including:

(a) encrypting at least a portion of the governed item (see column 10, lines 56-57; figure 2, block 108b; encrypted database information fields);

(b) storing the governed item in a memory of the a first processing arrangement at a first site (see column 11, lines 34-36; figure 1, block 200; figure 2, blocks 106 and 108b; controlling the host computer to load one or more of the encrypted data blocks);

(c) receiving a first rule set made up of one or more rules at the first processing arrangement, received directly and indirectly from a second processing arrangement located at a second site located remotely from the first site (see column 11, lines 28-42; figure 1, blocks 100, 200, and 300; figure 2, blocks 106 and 108c; a user request causing the computer to load blocks of information specified by the user including decryption key fields; column 19, lines 31-39; where the customer site is located remotely from the storage medium);

(d) at the first processing arrangement, decrypting at least a portion of the governed item, being governed by one or more of the first rule set rules (see column 9, lines 30-33; figure 1, blocks 200 and 300; the decoder/biller is either a hardware component apart of or computer software executing on the host computer; see column 11, lines 8-14; column 12, lines 47-52; figure 1, block 300; figure 2, blocks 108b and 108c; decrypting the information with the decryption key);

(e) at the first processing arrangement, making a use of the governed item, being governed at least in part by one or more of the first rule set rules (see column 12, lines 47-52; figure 1, blocks 300 and 200; figure 2, blocks 108b and 108c; decrypting the information with the decryption key for display, storage, printing, telecommunications, or otherwise available to the user); and

(f) at the first processing arrangement, storing audit-related information relating to the use of the governed item, being governed at least in part by one or more of the first rule set rules (see column 12, lines 29-34; figure 1, block 300; storing all necessary billing and usage information in a non-volatile memory device).

As per claim 96, Shear further discusses:

(g) using at least a portion of the audit-related information to determine a payment (see column 12, lines 29-34; storing all necessary billing information).

As per claim 97, Shear also points out:

the audit-related information includes payment information (see column 19, lines 26-30; budgeting database use to an amount selected for payment).

As per claim 98, Shear then suggests:

the audit-related information includes identification information (see column 19, lines 15-26; keeping a running total on the type of information that can be decrypted).

As per claim 99, Shear next specifies:

The audit-related information includes information at least in part identifying the first processing arrangement and a user of the first the first processing arrangement (see column 19, lines 26-30; permitting a user to budget his database use on the host computer).

As per claim 100, Shear moreover elaborates:

(g) receiving a second rule set made up of one or more rules at the first processing

arrangement, being received separately from the first rule set (see column 19, lines 15-22; figure

3, block 314; permitting the user to store in the decoder/biller ceilings on database usage or cost

of usage based on usage, period of time, and/or type of information which can be decrypted).

As per claim 101, Shear also points out:

the second rule set is directly or indirectly received from a third processing arrangement

located at a third site remote from the first and from the second site (see column 19, lines 28-30;

permitting an organization to directly limit the cost of database access by employees to an

amount selected by the organization; see column 19, lines 12-15; by programming parameters to

limit the user's use of database information).

As per claim 102, Shear further discusses:

(h) using a rule from the second rule set to at least in part govern an aspect of access to

and use of the governed item (see column 11, lines 8-14; column 12, lines 47-52; figure 1, block

300; figure 2, blocks 108b and 108c; decrypting the information with the decryption key; see

column 19, lines 22-26; figure 4a, block 410; until the total of decrypted data exceeds the user-

specified parameter value).

As per claim 103, Shear then suggests:

using the second rule includes at least in part governing an attempt to transfer at least a

portion of the governed data item from the first data processing arrangement to a different

processing arrangement (see column 19, lines 22-26; ceasing decrypting database information if

the total exceeds the user-specified parameter value; column 12, lines 47-52; to prevent returning

decrypted information for telecommunications).

As per claim 108, Shear delineates a method including:

storing a first control in a memory of a processing arrangement (see column 19, lines 15-

22; figure 3, block 314; permitting the user to store in the decoder/biller ceilings on database

usage or cost of usage based on usage, period of time, and/or type of information which can be

decrypted);

at the processing arrangement, receiving a second control (see column 11, lines 28-42;

figure 1, blocks 200 and 300; figure 2, block 108c; received user request to control the computer

to strip off contents of the encrypted fields to be sent to the decoder/biller block);

using the first and second control to at least in part govern the decryption of at least a

portion of the data item (see column 11, lines 8-14; column 12, lines 47-52; figure 1, block 300;

figure 2, blocks 108b and 108c; decrypting the information with the decryption key resulting

from the user request; see column 19, lines 22-26; figure 4a, block 410; until the total of

decrypted data exceeds the user-specified parameter value); and

using the first control and second control to govern an aspect of access to and use of the

data item, including requiring that audit-related information be stored (see column 19, lines 22-

26; figure 1, block 200; figure 4a, block 416; keeping a running total of the parameters that the

user has specified; see column 19, lines 15-22; figure 3, block 314; in accordance with the

ceilings on database usage or cost of usage based on usage, period of time, and/or type of

information which can be decrypted).

As per claim 109, Shear also points out:

the stored information includes information relating to payment for the access or use of

the data item (see column 19, lines 26-30; budgeting database use to an amount selected for

payment).

As per claim 110, Shear depicts a method of controlling an operation at a processing

arrangement including a memory, a removable memory reader and a communications port,

including:

storing a first digital control in the memory (see column 19, lines 15-22; figure 3, block

314; permitting the user to store in the decoder/biller ceilings on database usage or cost of usage

based on usage, period of time, and/or type of information which can be decrypted);;

inserting a removable memory into the removable memory reader (see column 9, lines 4-

11; figure 1, blocks 100 and 200; predefined database(s) stored on a storage medium are read by

a host computer; see column 9, lines 38-46; figure 1, block 100; where the database storage

medium is an optical disk);

detecting a governed item stored in the removable memory, being at least in part

encrypted (see column 11, lines 28-33; figure 2, blocks 102 and 106; reading the index

information stored in the medium to ascertain which database blocks contain information

specified by the user request; column 10, lines 56-57; figure 2, block 108b; stored in encrypted

database information fields);

receiving a second digital control through the communications port (see column 11, lines

28-42; figure 1, blocks 200 and 300; figure 2, block 108c; sending a user request to cause the

decryption key fields to be sent to the decoder/biller for storage for processing user-selected

information blocks);

using at least a portion of the governed item, being governed at least in part by the first

digital control and the second digital control (see column 11, lines 8-14; column 12, lines 47-52;

figure 1, block 300; figure 2, blocks 108b and 108c; decrypting the information with the

decryption key; see column 19, lines 22-26; figure 4a, block 410; until the total of decrypted data

exceeds the user-specified parameter value); and

storing audit-related information relating to the use of the governed item (see column 19,

lines 22-26; figure 1, block 200; figure 4a, block 416; keeping a running total of the parameters

that the user has specified; see column 19, lines 15-22; figure 3, block 314; in accordance with

the ceilings on database usage or cost of usage based on usage, period of time, and/or type of

information which can be decrypted).

As per claim 111, Shear further specifies:

that the removable memory is an optical disk (see column 9, lines 38-46; figure 1, block

100; where the database storage medium is an optical disk).

As per claim 112, Shear additionally points out:

that the second digital control is directly received from a second processing arrangement

located remotely from the first processing arrangement (see column 11, lines 28-42; figure 1,

blocks 200 and 300; figure 2, block 108c; sending a user request to cause the decryption key

fields to be sent to the decoder/biller for storage for processing user-selected information blocks;

see column 19, lines 28-30; permitting an organization to directly limit the cost of database

access by employees to an amount selected by the organization; see column 19, lines 12-15; by

programming parameters to limit the user's use of database information).

16.   Claims 91-103, and 108-112 are rejected under 35 U.S.C. 102(f) because the applicant

did not invent the claimed subject matter. Only one of the applicants of the instant application is

the sole inventor of Shear, U.S. Patent No. 5,050,213 A. See MPEP § 2137.

17.   Claims 106 and 107 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik et

al., U.S. Patent No. 5,638,443 A.

As per claim 106, Stefik et al. disclose a method of governing an operation at a

processing arrangement, including:

(a) at the processing arrangement, receiving a first control directly or indirectly from a

first party (see column 36, lines 22-27; sending to the server a message to initiate a play

transaction, including the work to be played, the identity of the player being used, and the file

data of the work);

(b) at the processing arrangement, receiving a second control indirectly from a second

party (see column 36, lines 32-33; the repository perform common opening transaction steps for

registration; see column 27, lines 32-48; figure 16, steps 1602 and 1603; registration message

comprised of an identifier of a master repository, an identification certificate for repository-1

encrypted by the master repository, and encrypted random registration identifier; see column 7,

lines 15-20; figure 2, items 201 and 205; where the master repository provides an identification

certificate to a requesting repository; see column 7, lines 1-14; figure 2, items 202 and 203;

which the requesting repository, in turn, sends it to rendering repository where authorization is

required);

(c) at the processing arrangement, using the first control (see column 36, lines 36-37;

playing the work contents according to the request) and second control (see column 28, lines 39-

43; playing the work contents upon successful completion of the registration transaction) to at

least in part govern a use of an item;

(d) storing a first type of audit-related information relating to the use of the item, required

by the first control (see column 29, lines 55-61; listing charges from the parts of the digital work

played); and

(e) storing a second type of audit-related information relating to the use of the item,

required by the second control (see column 29, lines 55-61; assigning a charge in accordance to

the identities of the repositories in the transaction).

As per claim 107, Stefik et al. specify:

that the information in step (e) includes at least in part identifying both the processing

arrangement (see column 29, lines 55-61; assigning a charge based on the repositories in the

transaction) and the user of the processing arrangement (see column 30, lines 5-10; a report-

charges transaction between a personal credit server and a billing clearinghouse, charging a

personal credit card).

Allowable Subject Matter

18.   Claims 104 and 105 are allowed.

19.   The following is an examiner's statement of reasons for allowance:

20.   Claims 104 and 105 are drawn to a method of performing a commercial process. The

closest prior art, Stefik et al., U.S. Patent No. 5,638,443 A, discloses a similar method. Although

Stefik et al. describe receiving a request (see column 36, lines 22-27), they neither teach nor

suggest receiving a first communication including a first programming module nor a second

communication including a second programming module. These particular steps explicitly

incorporated into independent claim 104 render claims 104 and 105 allowable.

Any comments considered necessary by applicant must be submitted no later than the

payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for

Allowance."

Conclusion

21.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Justin T. Darrow whose telephone number is (703) 305-3872 and

whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be

reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barrón, Jr., can be reached at (703) 305-1830.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-

9306. In order for a formal paper transmitted by fax to be entered into the application file, the

paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal
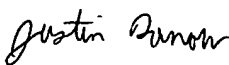
papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only "**OFFICIAL FAX**" but also "**AMENDMENT AFTER FINAL**".

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

May 28, 2004

JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100